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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,595	10/04/2000	Ernest S.Y. Wong	391442004300	8464

25225 7590 06/05/2003  
MORRISON & FOERSTER LLP  
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SAN DIEGO, CA 92130-2332

EXAMINER
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LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/05/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/678,595

Applicant(s)

WONG ET AL.

Examiner

Hong Liu

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-7 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1624

### **DETAILED ACTION**

Claims 1, 3-7, and 14-20 are pending in this application.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 9, 2003 has been entered.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4, 6, 7, 15, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Broomhead et al., Chem Abstract 124: 248674. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS computer search report and the compound having RN 174585-20-7, i.e., A is chloro, X is NH<sub>3</sub>, and Z is substituted pyrzaole.

Claims 1, 3-4, 6, 7, 15, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Muir et al., Chem Abstract 108: 215259. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS computer search report and the

Art Unit: 1624

compound having RN 114487-38-6, i.e., A is chloro, X is NH<sub>3</sub>, and Z is methyl substituted imidazole.

Claims 1, 3-4, 6, 7, 15, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Saudek et al., Chem Abstract 102:124545. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS computer search report and the compound having RN 95381-03-6, i.e., A is chloro, X is NH<sub>3</sub>, and Z is imidazole substituted with an alkyl group.

### ***Claim Rejections - 35 USC § 103***


The amendment filed on September 10, 2002 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: rejection to claims 1, 3-7 and 14-20 under 35 U.S.C. 103(a) as being unpatentable over Murrer et al. (US 5,665,771) is maintained for reasons of previous office action which are incorporated herein by reference. Applicants' arguments citing case laws are fully considered and are not found persuasive. Unlike the situation in *Baird*, the Murrer reference not only generically teaches that Z can be a 5-, or 6- monocyclic amine, it also discloses specific species, i.e., pyridine. Although the amended claims eventually exclude pyridine from the genus, the generic teaching of Murrer coupled with its specific showing of a 5- or 6- membered unsaturated heterocyclic amine would provide sufficient motivation for one skilled in the art to select the claimed compounds from the genus in the reference to arrive at the present invention. Applicants also argue that the claimed compounds have improved solubility

Art Unit: 1624

and antitumor activity. However, applicants have not shown side by side that the claimed compounds are superior to the reference compounds in the treatment of cancer.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

Hong Liu  
June 3, 2003

  
**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**